

REMARKS

Claims 1-6 are present in the instant application. In the most recent Office Action, the specification is objected to alleging inadequate antecedent basis for the means-plus-function features recited in the claims. Claims 2 and 3-4 are objected to for minor informalities. Claims 1-6 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Pat. No. 6,674,873 to Donescu, et al. (hereinafter, "Donescu").

With respect to the claim objections, as amended above, claims 2-6 have been cured of the editorial errors noted in the Office Action and others. The amendments are clerical in nature only, and shall not be construed as a surrender of any subject matter relative to the claims as filed. No new matter has been added by the amendments. Favorable reconsideration and withdrawal of the claim objections is kindly solicited.

Turning to the specification objection, Applicant respectfully traverses the objection as poorly taken. In the first instance, at present the application includes only 6 claims, therefore the reference to claims 64-81 and 141-158 (Office Action, p. 2) is apparently in error. The Office Action cites M.P.E.P., 8th Ed., Rev. 2, § 2181 (May 2004), and alleges that the specification fails to adequately link corresponding structure, material or acts to the means-plus-function limitations in the claims. Applicant respectfully disagrees.

With reference to the M.P.E.P. § 2181, the requirement to amend the specification or state on the record the correspondence of structure, material or acts to claimed function should be made where such correspondence is at least inherently or implicitly set forth. See, *id.*, IV. Determining whether 35 U.S.C. 112, First Paragraph Support Exists.

Therefore, the Office Action acknowledges that the corresponding structure, material or acts is at least inherently or implicitly disclosed.

However, Applicant submits that the correspondence is explicit when one reads the specification, and that no further amendment or statements on the record are necessary. Applicant concedes that the specification does not use the precise word "means" in identifying the correspondence between the structure, material or acts and their function. However, the clear linguistic consistency between the specification and the claims establishes both the correspondence and the antecedent basis that the objection alleges is lacking. Moreover, nowhere in the U.S.C. or the C.F.R. is the requirement set forth that the specific word "means" *ipsissimis verbis* is the sole method for establishing correspondence between a function and its structure, material or acts. In this regard, the leading case of the Federal Circuit requires only that the specification "[C]learly links or associates that structure to the function recited in the claim." *B. Braun Medical Inc. v. Abbott Laboratories*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997). Such clear association is already present in the instant specification.

Applicant respectfully submits that in light of this, the correspondence between the recited function in the claims and the respective structure, materials or acts are explicitly set forth through the original specification as filed. "If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more." *Solomon v. Kimberly-Clark Corp.*, 16 F.3d 1372, 55 USPQ2d 1279, 1282 (Fed. Cir. 2000). Therefore, favorable reconsideration and withdrawal of the objection is kindly requested.

Turning to the merits of the claims, Applicant respectfully traverses the rejection, for at least the reasons set forth below. Claims 1 and 2 each recite an electronic watermark data insertion apparatus comprising, *inter alia*, electronic watermark data selecting means for selecting particular electronic watermark data designated by an insertion information block by block from an electronic watermark memorizing means to produce a selected electronic watermark data. The Office Action avers this feature to be taught in Donescu. Applicant respectfully disagrees.

The portion of Doescu cited in the Office Action reads in its entirety:

It should be noted that the blocks of the image are considered and processed in a predetermined order, for example in the video scanning order, and that, in a given block, the coefficients also considered in a predetermined order, for example also in a zigzag from the top left-hand corner to the bottom right-hand corner.

According to the invention, the device has a watermarking circuit 5 which inserts a secret watermark in the data compressed by means of the circuits 2, 3 and 4, here a compressed image.

(Donescu, Col. 7, lines 21-30)

The Office Action goes on to aver that memory to store watermark data, information stored on what part of the watermark data to insert, and means for selecting where to insert the watermark data are all inherent. However, nowhere in the cited portion, nor elsewhere in Donescu, is there any teaching or suggestion of the recited electronic watermark data selecting means, nor any of the other features the Office Action alleges to be inherent.

To support a *prima facie* case of anticipation by inherency, the limitation in question must “necessarily” be present in the prior art reference. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999) “In relying upon the theory of inherency,

the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In this case, the features alleged as inherent are not *necessarily* present in Donescu. Contrary to the Office Action's assertions, watermark insertion apparatus need not include a plurality of electronic watermark data, which are chosen from a memorizing means memorizing the same; a single watermark may be stored and inserted. Moreover, there is no teaching or suggestion, nor allegation of inherency, with respect to the recited electronic watermark data selecting means, precisely because a single watermark may be stored and inserted. Therefore Applicant respectfully submits that claims 1 and 2 are patentably distinguished over Donescu.

Turning to claims 3-6, each of these claims recites an electronic watermark detection apparatus comprising, *inter alia*, insertion information memorizing means for preliminarily memorizing insertion information for designating a type of electronic watermark data to be inserted block by block in one frame divided into a plurality of blocks, electronic water watermark data detecting means for calculating a statistical similarity between extracted data and the respective electronic watermark data stored in an electronic watermark data memorizing means, and determining means for determining, on the basis of said statistical similarity, whether or not said electronic watermark data is detected. The Office Action avers these features to be taught by Donescu at Col. 13, lines 25-46. Further the Office Action avers that means for memorizing the type of watermark data and the watermark data are inherent (OA, p. 7). Applicant respectfully disagrees.

In the first instance, the allegations of inherency are again bare and unsupported by basis or reasoning why the features are *necessarily* present. See, *Ex parte Levy, supra*. Moreover, Donescu offers no teaching or suggestion, in the cited portion or elsewhere, of the insertion information memorizing means, watermark data detecting means or determining means as recited in the claims.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984). Therefore, Applicant respectfully submits that the rejection of claims 1-6 have been obviated, and kindly requests favorable reconsideration and withdrawal.

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter, and kindly solicits an early indication of allowability of all claims. If the Examiner has any reservation in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at an earliest convenience.

Respectfully submitted,



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